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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,210	07/14/2003	Craig B. Queen	50983/US	8720

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EXAMINER

DELCOTTO, GREGORY R

ART UNIT PAPER NUMBER

1751

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/620,210

Applicant(s)

QUEEN, CRAIG B.

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10-03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. Claims 1-18 are pending.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

#### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 11-15, 17, and 18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Librizzi (US 6,514,918).

Librizzi teaches a cleansing composition which is mild to the skin and eyes containing a fatty acid alkanolamide having the same general formula as recited by the instant claims, and an anionic surfactant. The compositions are useful as shampoos, washes, baths, gels, etc. See Abstract. Additionally, the compositions may contain a secondary surfactant selected from nonionic, amphoteric, betaine, cationic surfactants, and mixtures thereof. Suitable nonionic surfactants include the fatty alcohol acid or amide ethoxylates, sorbitan ester ethoxylates, etc. See column 2, lines 1-65. Additionally, thickening agents may be used and these include mono or diesters of polyethylene glycol having 3 to about 200 moles of ethylene oxide and fatty acids

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having from 16 to 22 carbon atoms. Preferred thickeners include PEG-150 distearate.

See column 4, lines 1-60. Note that, the Examiner asserts that PEG-150 distearate corresponds to the polyethoxylated fatty acid diesters as recited by the instant claims.

Specifically, Librizzi et al teach a cleansing composition containing 0.6% disodium lauroamphodiacetate, 3% sodium trideceth sulfate, 1% PPG-2-hydroxyethyl cocamide, 1.9% glycerin, 1% PEG-120 methyl glucose dioleate, 3.3% POE 80 sorbitan monolaurate, 2.8% cocamidopropyl betaine, 0.1% tetrasodium EDTA, water, etc. See column 6, line 60 to column 7, line 10. Note that, with respect to the HLB of the nonionic surfactant as recited by the instant claims, the Examiner asserts that PEG-120 methyl glucose dioleate and POE 80 sorbitan monolaurate as specifically disclosed by Librizzi et al would inherently have the same HLB values as recited by the instant claims because these nonionic surfactants fall within those listed in instant claim 2. Librizzi et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Librizzi et al anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Librizzi not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the nonionic surfactant having the specific HLB value of the composition in order to provide the optimum cleaning properties to the composition because Librizzi teaches that the types of nonionic surfactant and

thickeners, which are the same as the nonionic surfactant recited by the instant claims, added to the composition may be varied.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Librizzi (US 6,514,918).

Librizzi is relied upon as set forth above. However, Librizzi does not teach, with sufficient specificity, a cleaning composition containing nonionic surfactant in addition to the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a cleaning composition containing nonionic surfactant in addition to the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Librizzi suggest a cleaning composition containing nonionic surfactant in addition to the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1-3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Queen et al (US 2003/0036498).

Queen et al teach adjuvant surfactant compositions for beneficially modifying the properties of surfactant systems. See Abstract. The invention relates to polypropylene glycol hydroxyethyl isostearamide compositions. See para. 01. Various surfactants may be added to the composition including anionic, cationic, nonionic, amphoteric or

zwitterionic surfactants, etc. See para. 27. Suitable zwitterionic surfactants include betaine surfactants. See para 50. Suitable nonionic surfactants include alkyl polysaccharides, ethoxylated fatty alcohols having from 5 to 150 moles of ethylene oxide and from about 6 to 30 carbon atoms, alkoxyated alkanoamides such as polypropylene glycol hydroxyethyl cocamide, polypropylene glycol hydroxyethyl caprylamide, etc. See paras. 64 and 66. Note that, Queen et al teach and suggest ethoxylated alcohols which would have the same HLB value as recited by the instant claims such as polyoxyethylene (20) isohexadecy ether and polyoxyethylene (23) lauryl ether.

Queen et al do not teach, with sufficient specificity, a liquid, flowable composition containing a nonionic surfactant, an alkoxyated alkanolamide, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teaching of Queen et al suggest a liquid, flowable composition containing a nonionic surfactant, an alkoxyated alkanolamide, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims .

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Librizzi (US 6,514,918) as applied to claims 1-6 and 11-18 above, and further in view of Queen et al (US 2003,0036498).

Librizzi is relied upon as set forth above. However, Librizzi does not teach the use of combination of polyoxyethylene (20) isohexadecy ether and polyoxyethylene (23)

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lauryl ether in addition to the other requisite components of the composition as recited by the instant claims.

Queen et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a combination of polyoxyethylene (20) isohexadecy ether and polyoxyethylene (23) lauryl ether in the cleaning composition taught by Librizzi, with a reasonable expectation of success, because Queen suggests the use of polyoxyethylene (20) isohexadecy ether and polyoxyethylene (23) lauryl ether as ethoxylated alcohol nonionic surfactants in a similar cleaning composition and, further Librizzi teaches the use of ethoxylated alcohols in general.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/840417 and claims 1-4, 6-18, and 20-23 of US appl.



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10/840418. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-23 of copending Application No. 10/840417 and claims 1-4, 6-18, and 20-23 of Application No. 10/840418 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a liquid, flowable composition containing a nonionic surfactant, an alkoxylated alkanolamide surfactant, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims, because claims 1-23 of copending Application No. 10/840417 and claims 1-4, 6-18, and 20-23 of US appl. 10/840418 suggest a liquid, flowable composition containing a nonionic surfactant, an alkoxylated alkanolamide surfactant, water, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

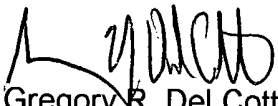
Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory R. Del Cotto  
Primary Examiner  
Art Unit 1751

GRD  
December 11, 2004